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2000 Galloping Hill Road
Kenilworth NJ 07033-0530

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OFFICE OF PETITIONS

Applicant: :
Chung et al. :
 : PETITION
Application No. 09/431,519 : ON REQUEST FOR RECONSIDERATION
Filed: November 1, 1999 : OF PATENT TERM ADJUSTMENT
Attorney Docket No.
1998.433-3 / AH0948Q :

This is a decision on the Request for Reconsideration of Patent Term Adjustment under 37 C.F.R. 1.705(B) filed on December 4, 2008.

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is DISMISSED as PREMATURE as to the amount of time accrued under 35 USC 154(b)(1)(B) and 37 CFR 1.702(b). The applicant request for review of the patent term adjustment as it relates to the applicant delays under 37 CFR 1.704 and the amount of delays awarded applicant under 37 CFR 1.702(a) is **GRANTED-IN-PART**.

Applicants assert in addition to the time accrued for "B" delay that they are also entitled to specific amounts of "A" delay and less applicant delay.

Applicants assert they are entitled to following:

- 1) 31 days under 37 CFR 1.703(a)(4);
- 2) 152 days under 37 CFR 1.703(b);

Applicants assert that there were reductions for the following events:

- 1) 6 days under 37 CFR 1.704(b)
- 2) 37 days pursuant to 37 CFR 1.704(b)
- 3) 83 days pursuant to 37 CFR 1.704(b)

Applicants do not cite any other reduction as a failure to engage in reasonable efforts to conclude prosecution of the application.

The Office cited seven events that reduced PTA for a total of 691 days and cited Office delay of 31 days.

Upon review of the determination, the Office and applicant agree to the reductions of 6 days and the reduction of 37 days. The Office also agrees with applicants that the delay of 380 days is errant and that the proper reduction is 83 days as asserted by applicant.

However, the Office further reiterates that the reductions of 86 days, 90 days, 62 days, and 30 days pursuant to 37 CFR 1.704(b) are proper and are being maintained.

As for the Office delay of 31 days, the Office asserts that such accrual is inaccurate. Pursuant to 37 CFR 1.703(a)(4), the Office is required to respond to a compliant appeal brief within four months. Under the present scenario, the compliant appeal brief was not filed until April 22, 2003. The Office reopened the application on July 22, 2003 within four months of the filing of the compliant appeal brief.

Accordingly, at the mailing of the notice of allowance the determination is the following: 0 days of Office delay - applicant delay(6 + 83 + 86 +90 +62 + 30 + 37= 394)= 0. The Office notes that if applicant delay is greater than Office delay then the Office will post notice to applicant that they received zero days. To avoid confusion, the Office does not advise appellant that they have a negative balance of (394) day balance at the time of the mailing of the notice of allowance. Accordingly, the Office delay is zero (0) days at time of the mailing the notice of allowance.

The Office will determine the amount of "B" delay at the time of the issuance of the patent and accordingly, it is premature to address whether appellants' calculation of 152 days is accurate.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee¹.

¹ For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d), meet the requirements of 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to Maria Nuzzolillo, Legal Advisor, at (571) 272-8150, or the undersigned at 571-272-7757.

/Kery A. Fries/

Kery A. Fries
Senior Legal Advisor
Office of Patent Legal Administration
Office of Associate Commissioner
for Examination Policy

calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

Day : Monday
Date: 6/28/2010

Time: 14:48:50

PALM INTRANET**PTA Calculations for Application: 09/431519**

Application Filing Date:	11/01/1999	PTO Delay (PTO):	31
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	691
Post-Issue Petitions:	0	Total PTA (days):	0
PTO Delay Adjustment:	266		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
148	06/28/2010	ADJUSTMENT OF PTA CALCULATION BY PTO	266		
139	10/01/2008	MAIL NOTICE OF ALLOWANCE			
138	09/29/2008	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
137	09/29/2008	CASE DOCKETED TO EXAMINER IN GAU			
136	09/29/2008	ISSUE REVISION COMPLETED			
135	09/29/2008	DOCUMENT VERIFICATION			
128	09/29/2008	ALLOWED CASE RETURNED TO THE EXAMINER FOR CLERICAL PROCESSING			
127	09/29/2008	NOTICE OF ALLOWABILITY			
126	07/07/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
125	07/07/2008	REFERENCE CAPTURE ON IDS			
124	07/07/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
123	08/16/2008	DATE FORWARDED TO EXAMINER			
122	07/21/2008	RESPONSE AFTER NON-FINAL ACTION		30	118
121	07/21/2008	REQUEST FOR EXTENSION OF TIME - GRANTED			
120	07/07/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
119	07/01/2008	CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA)			
118	03/21/2008	MAIL NON-FINAL REJECTION			
117	03/17/2008	NON-FINAL REJECTION			
116	02/22/2008	CORRESPONDENCE ADDRESS CHANGE			
115	12/26/2007	FEE PAYMENT RECORDED (FEES FILED SEPARATELY E.G. NOT WITH ORIGINAL			

		PAPERS, ETC).			
114	01/12/2008	DATE FORWARDED TO EXAMINER			
113	12/26/2007	RESPONSE AFTER NON-FINAL ACTION		62	111
112	12/26/2007	REQUEST FOR EXTENSION OF TIME - GRANTED			
111	07/25/2007	MAIL NON-FINAL REJECTION			
110	07/23/2007	NON-FINAL REJECTION			
109	05/21/2007	DATE FORWARDED TO EXAMINER			
108	05/11/2007	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
107	05/21/2007	DATE FORWARDED TO EXAMINER			
106	05/11/2007	REQUEST FOR CONTINUED EXAMINATION (RCE)			
105	05/21/2007	DISPOSAL FOR A RCE / CPA / R129			
104	05/11/2007	REQUEST FOR EXTENSION OF TIME - GRANTED			
103	05/11/2007	WORKFLOW - REQUEST FOR RCE - BEGIN			
102	12/13/2006	NOTICE OF APPEAL FILED		90	99
101	12/13/2006	REQUEST FOR EXTENSION OF TIME - GRANTED			
100	08/03/2006	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
99	06/14/2006	MAIL FINAL REJECTION (PTOL - 326)			
98	06/12/2006	FINAL REJECTION			
97	04/06/2006	DATE FORWARDED TO EXAMINER			
96	04/03/2006	RESPONSE AFTER NON-FINAL ACTION		86	94
95	04/03/2006	REQUEST FOR EXTENSION OF TIME - GRANTED			
94	10/07/2005	MAIL NON-FINAL REJECTION			
93	10/03/2005	NON-FINAL REJECTION			
92	07/20/2005	DATE FORWARDED TO EXAMINER			
91	07/14/2005	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
90	07/20/2005	DATE FORWARDED TO EXAMINER			
89	07/14/2005	REQUEST FOR CONTINUED EXAMINATION (RCE)			
88	07/20/2005	DISPOSAL FOR A RCE / CPA / R129			
87	06/07/2005	NOTICE OF APPEAL FILED		380	51
86	05/24/2005	MAIL ADVISORY ACTION (PTOL - 303)			
85	05/23/2005	ADVISORY ACTION (PTOL-303)			

84	05/09/2005	REFERENCE CAPTURE ON IDS			
83.7	05/09/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
83	05/09/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
82	05/12/2005	DATE FORWARDED TO EXAMINER			
81	04/09/2005	AMENDMENT AFTER FINAL REJECTION			
80	05/09/2005	REQUEST FOR EXTENSION OF TIME - GRANTED			
58	04/05/2005	CASE DOCKETED TO EXAMINER IN GAU			
57	12/16/2004	MAIL NOTICE OF RESTARTED RESPONSE PERIOD			
56	12/16/2004	LETTER RESTARTING PERIOD FOR RESPONSE (I.E. LETTER RE: REFERENCES)			
55	12/16/2004	MAIL NOTICE OF RESCINDED ABANDONMENT			
54	12/16/2004	NOTICE OF RESCINDED ABANDONMENT IN TCS			
53	09/24/2004	MAIL ABANDONMENT FOR FAILURE TO RESPOND TO OFFICE ACTION			
52	09/23/2004	ABAND. FOR FAILURE TO RESPOND TO O. A.			
51	02/23/2004	MAIL FINAL REJECTION (PTOL - 326)			
50	02/17/2004	FINAL REJECTION			
49	12/19/2003	DATE FORWARDED TO EXAMINER			
48	11/28/2003	RESPONSE AFTER NON-FINAL ACTION		37	46
47	11/28/2003	REQUEST FOR EXTENSION OF TIME - GRANTED			
46	07/22/2003	MAIL NON-FINAL REJECTION	31		40
45	07/07/2003	NON-FINAL REJECTION			
44	04/30/2003	DATE FORWARDED TO EXAMINER			
43	04/22/2003	APPEAL BRIEF FILED			
42	03/19/2003	NOTICE -- DEFECTIVE APPEAL BRIEF			
41	03/17/2003	DATE FORWARDED TO EXAMINER			
40.1	02/21/2003	DEFECTIVE / INCOMPLETE APPEAL BRIEF FILED			
40	02/21/2003	APPEAL BRIEF FILED			
39	03/06/2003	MAIL ADVISORY ACTION (PTOL - 303)			
38	03/06/2003	ADVISORY ACTION (PTOL-303)			
37	03/05/2003	DATE FORWARDED TO EXAMINER			
36	02/21/2003	AMENDMENT/ARGUMENT AFTER NOTICE OF APPEAL			

35	12/16/2002	NOTICE OF APPEAL FILED			
34	10/23/2002	MAIL FINAL REJECTION (PTOL - 326)			
33	10/18/2002	FINAL REJECTION			
32	08/01/2002	DATE FORWARDED TO EXAMINER			
31	06/24/2002	RESPONSE AFTER NON-FINAL ACTION		6	30
30	03/18/2002	MAIL NON-FINAL REJECTION			
29	03/06/2002	NON-FINAL REJECTION			
28	02/11/2002	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
27	03/01/2002	DATE FORWARDED TO EXAMINER			
26	02/11/2002	CONTINUING PROSECUTION APPLICATION - CONTINUATION (ACPA)			
25	03/01/2002	DISPOSAL FOR A RCE / CPA / R129			
24	02/11/2002	REQUEST FOR EXTENSION OF TIME - GRANTED			
23	02/11/2002	WORKFLOW - REQUEST FOR CPA - BEGIN			

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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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